

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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SEP 29 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES J. STOUFFER and DAVID C. BUGBY

Appeal No. 2005-1372
Application 09/434,507

ON BRIEF

Before KIMLIN, PAK and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

REMAND

We remanded the application to the examiner on October 23, 2003 for the examiner to 1) address an apparent inconsistency in Gieser as to whether the disclosed welding is melt welding or diffusion welding and 2) search the diffusion bonding art, particularly class 228, subclass 193.

The examiner's total response to our remand was: "It is examiner's position that Gieser's welding is diffusion welding" (paper no. 22, mailed March 9, 2004).

Appeal No. 2005-1372
Application 09/434,507

The case was returned to the examining group and a different examiner stated that if it is found that Gieser does not anticipate or render obvious the appellants' claimed invention, then it would appear appropriate to make a rejection under 35 U.S.C. § 103 over Gieser in view of U.S. 6,264,095 Stouffer et al. (Stouffer) (communication mailed July 11, 2005).¹ The examiner, however, did not actually make a rejection. The appellants responded by arguing that Stouffer is not prior art because it has the same filing date as provisional application 60/143,916 which, the appellants argue, is relied upon by the present application for priority (reply filed August 11, 2005).

We remand the application to the examiner and the appellants to establish whether the appellants have filed a communication claiming priority of provisional application 60/143,916 and, if so, whether that provisional application 1) predates Stouffer and any additional relevant prior art found by the examiner, and 2) provides adequate written descriptive support for the appellants' claimed invention.

¹ Stouffer is the reference cited by the board to show the relevance of class 228, subclass 193 (decision, page 5, footnote 7).

Appeal No. 2005-1372
Application 09/434,507



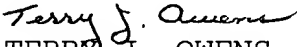
We further remand the application to the examiner for the examiner to 1) address the apparent inconsistency in Gieser pointed out by the board regarding whether the disclosed welding is melt welding or diffusion welding (decision, pages 2-5), and 2) search the diffusion bonding art if the examiner has not done so, indicate on the record the field of search of any previous or present search, and make any appropriate rejections over the prior art (including Stouffer).²

² In an interview summary (filed December 13, 2004) the appellants stated that they were told by the examiner that the examiner had searched the diffusion bonding art and did not find any relevant art (i.e., the board found the only relevant reference in the diffusion bonding art), but the examiner has not stated on the record that the diffusion bonding art was searched and set forth the field of search.

Appeal No. 2005-1372
Application 09/434,507

This application, by virtue of its "special" status, requires an immediate action. See Manual of Patent Examining Procedure § 708.01 (8th ed. Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

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EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
TERRY J. OWENS)	
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Appeal No. 2005-1372
Application 09/434,507

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